

Serial No. 09/765,540
Filed: January 19, 2001

REMARKS/ARGUMENTS

In the Office Action, the Patent Office rejected claims 1 to 6, 8 to 12, and 15 to 18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over United States Patent No. 5,389,546 (Becket) in view of United States Patent No. 5,667,760 (Sweeney) and "Potentiometric pH-stat titration", Experientia (Ballantyne); rejected claim 7 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Becket in view of Sweeney and Ballantyne and further in view of United States Patent No. 5,340,541 (Jackson); and rejected claims 13 and 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Becket in view of Sweeney and Ballantyne and further in view of United States Reissue Patent No. 28970 (Shapiro). These rejections are traversed for the reasons set forth below.

With regard to the rejection of claims 1 to 6, 8 to 12 and 15, to 18, the Patent Office is of the opinion that it would have been obvious to modify the teachings of Becket with Sweeney since teaches that normality facilitates the process by excluding weighing. Ballantyne is added to allegedly teach nitrogen as a protective inert atmosphere.

The Patent Office is of the opinion that Becket and Sweeney teach a titration method that excludes weighing. Applicants note, however, that amounts of aqueous base developer and acid titrant are weighed in the instant invention. See, for example, steps (a) and (b) of claim 1. There is absolutely no teaching in Becket and Sweeney, either alone or together that would cause one of ordinary skill in the art to conclude that applicants' invention is obvious in view of the alleged combination of Becket and Sweeney since neither of those documents teach or suggest weighing. The Patent Office

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states that Sweeney excludes weighing. Thus, how is applicants' invention obvious when it uses weighing?

Even with the alleged teaching of Ballantyne in combination with Becket and Sweeney, the Patent Office has not made out a prima facie case of obviousness as applicants' invention involves weight the aqueous base developer and acid titrant whereas Becket and Sweeney exclude weighing.

The Patent Office has suggested (top paragraph on page 4 of the Office Action) that it is well known in the art that titrations are performed slowly, or even stopped, as you near the endpoint. However, the Patent Office has not provided any documentary support that that suggestion and a rejection based on obviousness must be based on facts or record and not unsubstantiated conclusions. The Patent Office is requested to provide documentation to support the Patent Office's position. See MPEP 2144.03.

As for the Patent Office's opinion as to claims 2 and 3, applicants note that the documents cited by the Patent Office do not weigh the reactants so the Patent Office's rejection of claims 2 and 3 as being obvious cannot stand.

The rejection of claims 1 to 6, 8 to 12 and 15 to 18 is traversed and withdrawal thereof is requested.

With regard to the rejection of claim 7, the Patent Office is of the opinion that Becket in view of Sweeney and Ballantyne fail to teach that reactants are weighed in closed containers and cites Jackson as teaching closed containers. Jackson teaches the use of rubber septum closed vial where a needle is used to add and remove contents.

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The method of Jackson does not involve the weighing of samples. While Jackson discusses prior art methods for moisture determinations using Karl-Fischer titrations, there is no mention of measuring the normality of solutions.

The rejection of claim 7 is traversed and withdrawal thereof is requested.

With regard to the rejection of claims 13 and 14, the Patent Office states that the plunger of Shapiro extends for about 75% of the burette length, pointing to Fig. 1 of Shapiro. Applicants disagree and call upon the Patent Office to provide a detailed explanation as to how it arrived at the 75% figure. Indeed, looking at the Shapiro document, Fig. 1 does not show the length of the plunger 21, showing only a partial part of it, given the break in burette 11 just about no. 13 and the break at around the 60 mark. Moreover, Shapiro states that in operation, "... the plunger 21 is depressed all the way, thereby delivering the desired volume of reagent through the tip 33." See column 2, lines 61 to 63. Clearly, Shapiro does not teach applicants' invention of claims 13 and 14.

The rejection of claims 13 and 14 is traversed and withdrawal thereof is requested.

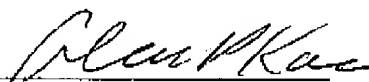
The Patent Office appears to be using applicants' application as a road map to pick and choose among many documents to arrive at applicants' invention. This, of course, is an incorrect way in which to allege that applicants' invention is obvious. The Patent Office cannot cite documents which merely indicate isolated elements to show obviousness. There must be some teaching or suggestion within the documents that would cause one of ordinary skill in the art to combine the documents and the Patent Office has shown this.

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Applicants also enclose a two (2) month extension of time.

Applicants submit that the concerns of the Patent Office have been addressed. Withdrawal of the rejections and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,



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